

REMARKS

By this Amendment, claims 1, 3-6 and 9 have been amended and claims 10-20 have been newly added. Claim 2 has been cancelled without prejudice or disclaimer. The Specification has been amended to include section subheadings. Support for the instant amendments may be found throughout the as-filed specification. No new matter has been entered. Accordingly, claims 1 and 3-20 are pending.

Reconsideration and allowance of the application based on the following remarks are requested.

Objection to the disclosure

The disclosure was objected to for failing to include section subheadings. In response, Applicant has amended the specification to include section subheadings as requested by the Examiner. Accordingly, the withdrawal of the objection to the disclosure is earnestly sought.

Rejection under 35 U.S.C. § 102(b)

Claims 1-9 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,305,044 to James *et al.* ("James"). However, solely in an effort to expedite prosecution, Applicant has amended independent claim 1 to clarify some of the differences of the claimed invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant submits that James fails to teach a polishing implement for polishing a shoe comprising, *inter alia*, a removable sachet provided on or to be provided on the structure that covers the first polishing layer at least partly, so that only after removal of the sachet, the first polishing layer is completely revealed; and the sachet comprising: a fiber layer impregnated with a polishing product forming a second polishing layer; and a protective layer; wherein, in a closed condition, the second polishing layer is covered by the protective layer, and while, in an opened condition, the second polishing layer is exposed for applying the polishing product to the shoe,

as recited in claim 1. Similarly, Applicant submits that James fails to teach a sachet for a polishing implement comprising, *inter alia*, a portion for removeably attaching to a structure; wherein, in a closed condition, the polishing layer is covered by a protective layer, and while, in an opened condition, the protective layer is folded back and the polishing layer is exposed for applying the polishing product to the shoe, as recited in claim 9.

First, Applicant submits that James fails to teach a fiber layer impregnated with a polishing product for applying the polishing product to the shoe. For example, wetting layer 8, of James, alleged by the Office Action to be the claimed polishing product, includes a cleaning solution for cleaning windshields, such as Prestones's Windshield De-Icer. [See James, col. 3, lines 1-6 and 44-46]. However, the Office Action has not shown how such a cleaning solution is capable of polishing shoes. Applicant points out that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

Second, even assuming, *arguendo*, that the cleaning solution of James might be capable of polishing shoes (which Applicant does not concede for at least the reasons discussed above), Applicant submits that James fails to teach a structure having a removable sachet, as recited in claim 1, or a sachet having a portion for removably attaching to a structure, as recited in claim 9. For example, James provides no indication that the inner wetting layer 8, alleged by the Office Action to be a part of the sachet, is removable from the flexible mitt 2. As such, James also fails to teach that, only after removal of the sachet, a first polishing layer is completely revealed, as recited by claim 1.

Further, Applicant submits that James fails to teach a sachet having a protective cover, that in an opened condition, a protective layer is folded back to expose a polishing layer, as

recited in claim 9. For example, James discloses, that: “Cover faces 5, 6 are releasably secured to pouch 3 to form mitt 2.” [James, col. 4, lines 54-55]. Thus, in use, the cover face 5 is peeled apart, completely, from the pouch 3 and mitt 2 to expose the inner wetting layer 8. [See James, col. 3, lines 31-35]. Indeed, James provides no indication that the cover face 5, alleged by the Office Action to be a part of the sachet, is **folded back** to expose a polishing layer.

Accordingly, the rejections of claims 1 and 9 are improper and should be withdrawn. Claim 2 has been cancelled and thus, the rejection thereof is moot. Dependent claims 3-8 are patentable because they depend from claim 1, for at least the reasons discussed above related to claim 1, as well as for the additional features they recite.

In addition, the Office Action has failed to show that James teaches “... wherein the polishing implement comprises an impermeable layer to which the sachet is attached to the structure, the impermeable layer having a surface greater than the sachet,” as recited in claim 3. Rather, in James, there does not appear to be any additional layer to which the inner wetting layer 8 and the cover face 5, alleged by the Office Action to correspond to the sachet, are attached to the flexible mitt 2, much less, an impermeable layer having a surface greater than the cover face 5 and/or the inner wetting layer 8. [See, e.g., James, FIG. 3].

Further, the Office Action failed to show that James teaches “...wherein in the opened condition, the sachet extends beyond an edge of the structure,” as recited in claim 4, or “... wherein the sachet is attached to a bottom side of the structure and, in use, in the opened condition, extends beyond an edge of the structure and, when folded back, a portion of the sachet is attached to a top side of the structure,” as recited in claim 6. Rather, the cover face 5 of James, alleged by the Office Action to be a part of the sachet, is completely removed from the mitt 2.

Lastly, the Office Action has failed to show that James teaches “... wherein while in the closed condition, the protective layer is folded over and is sealed off along its edges, while the sachet is provided on the structure on one side of the fold,” as recited in claim 5. Rather, James provides no indication that the cover face 5, alleged by the Office Action to be a part of the sachet, is folded over while in the closed position.

New claims 10-13

New claims 10-12 are patentable because they depend from claims 1 and 9, for at least the reasons discussed above related to claims 1 and 9, as well as for the additional features they recite.

New claim 13 recites "...wherein, in a closed condition, the second polishing layer is covered by the protective layer, and while, in an opened condition, the protective layer is folded back and the second polishing layer is exposed for applying the polishing product to the shoe." Applicant submits that claim 13 is patentable for similar reasons as discussed above related to claims 1 and 9. New claims 14-20 are patentable because they depend from claim 13, as well as for the additional features they recite.

Conclusion


Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account

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